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REMARKS

Reconsideration and allowance are requested. Applicants request entrance of the
above amendments to the claims and consideration of the Remarks below. Claims 29, 30, 34,
35 and 39 - 44 are pending. Claims 29, 30, 34, 35 and 39 are amended.

Rejection of Claim 29 Under Section 102(e) in View of Suzuki et al.

Applicants thank the Examiner for noting that the rejection under Section 102(e) will
be withdrawn for claim 29 upon entry of the above amendments.

**Rejection of Claims 34, 39 - 41 and 43 - 44 Under Section 103 in View of Suzuki
et al. and Chang et al.**

Applicants thank the Examiner for indicating that the rejection under Section 103 of
claims 34, 39 - 41 and 43 - 44 in view of Suzuki et al. and Chang et al. will be withdrawn
upon entry of the above amendments.

**Rejection of Claims 39 - 40 Under Section 103 in view of Suzuki et al., Chang et
al. and N1993**

The Examiner maintains his rejection of claims 29-30, 34 - 35 and 39 - 44 under
Section 103(a) in view of Suzuki et al., N1993 and Chang et al. Applicants respectfully
traverse this rejection for several reasons.

The Examiner Cannot Take Competing Interpretations of Suzuki et al.

The Examiner is inappropriately taking completely different interpretations of Suzuki
et al. depending on which section (102 or 103) of the code the rejection is applied to. For
example, in the Advisory Action dated 03/09/2005, under paragraph 1a, the Examiner states,
with reference to the Section 102(e) rejection, that "the Examiner considered Suzuki's one-bit
flag for scalability to be the priorities assigned to video object layers (VOL)." (This is the
"Section 102" analysis). However, in paragraph 1b, when the Examiner maintains the
rejection of the claims under Section 103, the Examiner interprets the one-bit flag for
scalability in a completely different way: "the Examiner did not rely on Suzuki to teach
assigning priorities to video object layers (VOL), namely, Suzuki's one-bit flag for scalability

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is not considered the assigned priorities of VOL." (The "Section 103" analysis). The

Examiner cannot have it both ways and interpret the teaching of the one-bit scalability flag in

opposite ways simply depending on the theory of rejection. One reason for this as discussed

below is that the different interpretations dramatically alter the Section 103 analysis.

(Applicants note that this also appears to be a change in the analysis by the Examiner

from the Final Office Action dated 11/22/2004 wherein the Examiner in paragraph 11

asserted that Suzuki et al. teach a method of prioritizing encoded video data streams and the

method comprised transmitting each VOL by transmitting the "one-bit flag scalability".

Therefore, the Examiner did previously reference the one-bit scalability flag of Suzuki et al.

as teaching a priority of the video object layer. This same analysis using the one-bit

scalability flag with reference to the priority of the VOL is mirrored in earlier office actions

as well. Now the Examiner asserts that this one-bit scalability flag is not considered as

assigning priorities of the VOL.)

If the Examiner's Section 102 analysis were maintained in the Section 103 rejection,

then Applicants argue that the Suzuki et al. patent already contains a priority flag in the one-

bit scalability flag. Therefore, incorporating a 3 bit flag from Table 7.2.4 would modify the

Suzuki et al. proposed verification model. This modification would not be obvious to one of

skill in the art because as discussed more fully below, a verification model is a common

framework for MPEG4 that a decoder must match to be compliant with the standard. If

Suzuki et al. urged a one-bit scalability flag to be used for priority, then adding another

priority flag or changing their priority flag would modify the model and change the

compliance requirements. Thus, one of skill in the art would not find motivation to make

such a change.

In contrast, if the one-bit scalability flag does not assign a priority as is alternately

stated by the Examiner in the Section 103 analysis, then this puts the Examiner in a much

better position to argue that syntax should be incorporated from N1993 to provide a priority

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to VOLs because no priority assignment exists in Suzuki et al.'s syntax. As can be seen, the differing interpretations by the Examiner unduly confuse the analysis thus requiring Applicants to argue a lack of motivation under both interpretations.

Applicants respectfully request that the Examiner maintain a consistent interpretation of the one-bit flag for scalability regarding whether it assigned priorities to VOLs. Based on the Section 102 arguments and some arguments previous presented by the Examiner regarding the Section 103 rejection, Applicants submit that the Examiner's overall interpretation is that he believes the one-bit flag for scalability does assign priority information. Therefore, Applicants respectfully request that the Examiner withdraw the analysis in paragraph 1b wherein the Examiner assumes an alternate interpretation of the one-bit flag for scalability.

There is No Motivation or Suggestion to Combine the References

There is simply no motivation or suggestion to combine these references merely on a conclusion that is provides "more flexibility in scalability." Suzuki et al. begin discussing their syntax in scalability "in conjunction with a MPEG4VM verification method." Col. 30, line 62. This means that they are proposing their syntax as the syntax to be used for MPEG4. As is known in the art, an MPEG4 compliant decoder must be able to handle any bitstream encoded according to the MPEG4 standard. Therefore, Suzuki et al. propose their scalability syntax for acceptance in the standard. Applicants respectfully submit that a modification to Suzuki et al.'s syntax would change their proposed standard such that a decoder may become non-compliant to their syntax.

Applicants note that in MPEG4 the common platform developed from input from many companies and sources was known as the verification model (VM). The VM was a completely defined encoding and decoding environment such that an experiment performed by multiple independent parties will produce essentially identical results. As stated in T.

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Ebrahimi, F. Periera, Context, Objectives, Process in MPEG4, Prentice Hall, 2002, section

1.3.3.1:

> A VM is a complete framework defined in text and with a corresponding software
> implementation, such that an experiment performed by multiple independent parties
> will produce essentially identical results. VMs are enabled to check the relative
> performance of different tools, as well as to improve the performance of selected
> tools. The MPEG-4 VMs were built after screening the proposals. The first VM (for
> each technical area, e.g., video, audio, and SNHC) was not the best proposal but a
> combination of the best tools, independent of the proposal to which they belonged.
> Each VM included normative and non-normative tools to create the *common
> framework* that allowed performing adequate evaluation and comparison of tools
> targeting the continuous improvement of the technology included in the VM. After
> the first VMs were established, new tools were brought to MPEG-4 and evaluated
> within the VMs following a core experiment procedure. The VMs evolved through
> versions as CEs verified the inclusion of new techniques or proved that included
> techniques should be substituted. At each VM version, only the best performing tools
> were part of the VM. If any part of a proposal was selected for inclusion in the VM,
> the proposer had to provide the corresponding source code for integration into the VM
> software in the conditions specified by MPEG.

With this information regarding how proposals were adopted into the MPEG4

standard, Applicants submit that one of skill in the art would not find it obvious to simply

insert a new section of code from Table 7.2.4 of N1993 into the VM proposed by Suzuki et

al. In addition, since the MPEP requires that the Examiner must ascertain whether a

motivation or suggestion exists to *one of skill in the art* to combine these references,

Applicants submit that the operation and strictness of the MPEG4 industry standard and how

compliance exists or does not exist must be part of the knowledge of one of skill in the art. In

other words, if modifying Suzuki et al.'s syntax in FIG. 35 with table 7.2.4 of N1993 would

render a decoder from being compliant with Suzuki et al.'s VM to being non-compliant with

their VM, then one of skill in the art would not likely make such a modification.

As cited in previous Responses, if a proposed modification would render the prior art

invention being modified unsatisfactory for its intended purposes, then there is no suggestion

or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ

1125 (Fed. Cir. 1984). Further, if the proposed modification of the prior art would change the

principle operation of the prior art invention being modified, then the teaching of the

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reference is not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810,

123 USPQ 349 (CCPA 1959). Applicants submit that changes Suzuki et al.'s syntax would

change the principle operation of their VM.

Applicants have previously argued that Suzuki et al. and ISO/IEC N1993 actually

teach away from their combination. In this regard, Applicants note that each prior art

reference must be considered in its entirety, as a whole, including portions that would lead

away from the claimed invention. MPEPG 2141.02. As previously argued, the reason for

this lies in the differing approaches as to the term scalability. Suzuki et al.'s entire purpose is

to introduce a new and different size/time scalability that was not proposed in the MPEG-4

standard as set forth in N1277. The N1277 reference defines an object-based temporal

scalability and spatial scalability with the base layer and enhancement layer. (A hybrid

scalability is also discussed) These different layers relate to temporal and spatial resolution

rather than the size versus time scalability proposed by Suzuki et al. Blending Suzuki et al.

with the N1993 document would alter the principle of operation of one or more of the

references. Therefore, without repeating the earlier arguments, Applicants submit that this is

an additional reason that precludes any motivation to combine.

In summary, Applicants urge the Examiner to maintain a single interpretation of the

teaching of Suzuki et al. with regards to the one-bit scalability flag. The Section 102

interpretation is the one most consistently asserted by the Examiner until the most recent

Advisory Action. Next, Applicants respectfully submit that there is no motivation or

suggestion to combine Suzuki et al. with N1993. Therefore, claims 29-30, 34 - 35 and 39 -

44 are patentable and in condition for allowance.

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CONCLUSION

Having addressed the rejection of the claims, Applicants respectfully submit that the

subject Application is in condition for allowance and a Notice to that effect is earnestly

solicited.

Respectfully submitted,

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